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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,859	06/24/2003	An-Kee Lim	1349.1194	7187
21171	7590	12/14/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			DOTE, JANIS L	
			ART UNIT	PAPER NUMBER
			1756	

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/601,859

Applicant(s)

LIM ET AL.

Examiner

Janis L. Dote

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 November 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see the attached, paragraph 1. (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 9, 11, 12, 15 and 23.
Claim(s) objected to: 24.
Claim(s) rejected: 1-8, 13, 14, 16, 21 and 22.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attached, paragraph 3.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP 1700
1700

**Notice of Non-Compliant
Amendment (37 CFR 1.121)**

Application No.

10/601,859

Examiner

Janis L. Dote

Applicant(s)

LIM ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 30 November 2005 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
 - ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other _____.
- ☐ 2. Abstract:
 - ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____.
- ☐ 3. Amendments to the drawings:
 - ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - ☐ C. Other _____.
- ☒ 4. Amendments to the claims:
 - ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
 - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☒ E. Other: see the attached, paragraph 2 for explanation.

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted within the time period set forth in the final Office action.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

Failure to timely respond to this notice will result in:

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

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1. The proposed amendments to claims 1, 5, 8, and 13, set forth in the amendment filed after the mailing of the final rejection on Nov. 30, 2005, raises numerous new issues that would require further consideration and/or a search including the issue of new matter. The examiner notes that the following examples are not exhaustive. For example, the proposed amendments to claims 1 and 5: (1) change the Bragg angle range of " $(2\theta \pm 0.2) = 9.5^\circ$ to 27.3° " to -- $(2\theta \pm 0.2) = 9.5^\circ$ to 27.1° -- (emphasis added); (2) change the phrase "using dispersing materials" to -- using a dispersion machine --; and (3) add the limitation that "the single layered electrophotographic photoreceptor exhibits an $E_{1/2}$ of about 0.16 to about 0.22 $\mu\text{Joules}/\text{cm}^2$ " The limitations described in items (1) through (3) were not present in the claims when the final rejection was mailed. Furthermore, the limitations described in items (1) and (3) raise rejections under 35 U.S.C. 112, first paragraph, for lack of an adequate written description of said limitations. The originally filed specification does not disclose the range of -- $(2\theta \pm 0.2) = 9.5^\circ$ to 27.1° --, but discloses the range of " $(2\theta \pm 0.2) = 9.5^\circ$ to 27.3° ". See the originally filed specification at paragraph 0016. There is no general disclosure in the originally filed specification for the $E_{1/2}$ range of "about 0.16

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to about 0.22 $\mu\text{Joules}/\text{cm}^2$." Examples 1-10 in the originally filed specification exemplify particular single-layered photoreceptors that exhibit values of $E_{1/2}$ of 0.169, 0.218, 0.182, 0.231, 0.2, 0.222, 0.22, 0.269, and 0.271 $\mu\text{Joules}/\text{cm}^2$. Those particular examples only provide antecedent basis for those particular photoreceptors. The examples do not provide an adequate written description for the photoreceptors broadly recited in the proposed amended claims. In addition, the proposed amendments to claims 5 and 13, deleting the recitation of "an electrically conductive substrate," raises rejections under 35 U.S.C. 112, second and first paragraphs, for omitting an essential element.

2. Notice of NON-COMPLIANT AMENDMENT (37 CFR 1.121)

Item C: Claim 9, labeled as "currently amended," is not in compliance with 37 CFR 1.121 because there are no markings (i.e., underlining indicating addition and double brackets or strikethrough indicating deletion) present in the claim to indicate that the claim has been amended.

3. The examiner's refusal to enter the amendment filed after the mailing of the final rejection on Nov. 30, 2005, renders applicants' arguments regarding said amendment moot.

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Claims 1-8, 13, 14, 16, 21, and 22 stand rejected for the reasons discussed in the final rejection mailed on Sep. 12, 2005. Furthermore, applicants' arguments regarding the rejection of claim 16 under 35 U.S.C. 112, first paragraph, for lack of an adequate written description, are not persuasive for the reasons discussed in the final rejection. As discussed in the final rejection, the originally filed specification does not disclose that the resin used to form the dispersion liquid, which comprises the charge generation material and a solvent, can be the resin mixture recited in instant claim 16. Rather, the originally filed specification discloses that the binder resin in the resultant single photoreceptive layer can be the resin mixture recited in instant claim 16.